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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,093	10/04/2000	Shridhar P. Joshi	47079-00064	1828

30223 7590 05/07/2003

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EXAMINER
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CAPRON, AARON J

ART UNIT	PAPER NUMBER
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3714  
DATE MAILED: 05/07/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/679,093	JOSHI, SHRIDHAR P.
	Examiner Aaron J. Capron	Art Unit 3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 25 February 2003.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 26, 29-39, 46-55 and 94-98 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 26, 29-39, 46-55 and 94-98 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ .                                   |

## DETAILED ACTION

This is a response to the Amendment received on February 25, 2003, in which claims 26, 30, 32-33 and 37 were amended. Claims 26, 29-39, 46-55 and 94-98 are pending.

Claims 1-25 and 87-93 have been withdrawn from further consideration by the Examiner as being drawn to nonelected invention (Group I), the requirement having been traversed in Paper No. 6, and requirement is made **FINAL**.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (e) the invention was described in–
  - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
  - (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 26, 29-36, 39, 46-53 and 94-98 are rejected under 35 U.S.C. 102(e) as being anticipated by Acres (U.S. Patent No. 6,254,483; hereafter “Acres”).

Referring to claim 46, Acres discloses a method of operating a gaming machine that includes displaying, on a video display (1:17-19) a plurality of standard game appearance (1:58-2:11); monitoring real time (6:51-54); automatically (abstract-predetermined changes) displaying modified game appearance, the artwork being associated with a holiday (2:46-2:52); randomly selected a plurality of outcomes of the

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gaming machine in response to the wager amount (slot machine). It is inherent that all gambling games have a theme/artwork. Most casinos use equivalent gaming machines, but have different artwork to distinguish themselves from their competitors.

Referring to claims 47, Acres discloses using an external clock in a hub server (Figures 1, 3 and 5, ref 24).

Referring to claim 48, Acres suggests using a clock that is internal to the processor (5:47-50 and abstract with reference to predetermined changes in variable such as time).

Referring to claims 49 and 51, Acres discloses the steps of displaying include the steps of downloading data corresponding to the game artwork (1:33-57).

Referring to claim 50, Acres discloses using steps to download data from a server (Figures 1, 3 and 5, ref 24).

Referring to claims 53, Acres teaches a game machine programmed to alter game display for timed or calendar events such as holidays (Figure 5).

Claims 94-97 correspond in scope to a method set forth for use of the method listed in claims 46-55 and are encompassed by use as set forth in the rejection above.

Claim 98 corresponds in scope to a gaming machine set forth for use of the method listed in claims 46-55 and 94-97 and are encompassed by use as set forth in the rejection above.

Claims 26, 34 and 39 correspond in scope to a method set forth for use of the structure listed in claims 46-55 and are encompassed by use as set forth in the rejection above.

Referring to claim 29, Acres discloses using a video display (abstract), such as a video poker machine.

Referring to claim 30, Acres discloses the ability to change one of the parameters, such as using a plurality of different type of game artwork to change the appearance of the game, based upon a predetermined variable, such as time of year and suggests including a type of thematic game artwork having a holiday motif by changing the background automatically with respect to time. Acres uses an example with respect to changing the payout features based upon a holiday, but also refers to changing other parameters, such as appearance, based on the holiday event (abstract; 3:15-20; 8:49-65, esp. 8:62-65). To change the appearance of a gaming machine based on a holiday event must be consistent with respect to the holiday; to do otherwise, would obscure the basis of the particular holiday event.

Referring to claim 31, Acres discloses changing the audio and appearance of the machine in response to time (3:15-20).

Referring to claims 32 and 33, Acres discloses a gaming machine that includes the visual elements are associated with the plurality of outcomes (status of the player) and the timing of the game (3:15-20).

Referring to claims 35-36, Acres discloses a gaming machine that includes scheduling/programming for timed events such as one day before a holiday to one day after the holiday (Figure 5).

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 37-38 and 54-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Acres in view of IGWB New '97 Games (hereafter "IGWB").

Acres discloses using game artwork but does not disclose using animated characters. However, IGWB discloses using character animation to provide enjoyment to the game (Pages 15-16: The paragraph on page 15 starting with "To present slots..." to the fourth full paragraph on page 16) in order for casinos to distinguish themselves from other casinos and to add extra excitement to the game. The two references are analogous since both references refer to gaming machines using themes/artwork. One would be motivated to combine the references in order to provide extra enjoyment to Acres game by adding animated characters and thus, attract more players. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the animated characters of IGWB into the invention of Acres and Morro in order to enhance player enjoyment.

Referring to claims 54 and 55, Acres in view of IGWB disclose a plurality of modified visual elements (IGWB:page 11: paragraphs 1-4) that are player selectable (video poker machines 1:58-2:11) and that are non-selectable (slot machines).

*Response to Arguments*

Applicant's arguments filed February 25, 2003 have been fully considered but they are not persuasive.

Applicant argues that the present invention distinguishes itself from Acres by the fact that the present invention requires that the gaming machine changes the theme of the game artwork at a predetermined time. Applicant further argues that Acres discloses changing the payback percentage based upon the holiday season. However, Acres further discloses changing other parameters with respect to the holiday season (8:62-65) and changing the sound and appearance of the game equally applies. Acres discloses that gaming machines configuration parameters, such as game appearance (abstract, 1:61-65), can be changed automatically in response to commands over the network. The commands are issued in response to predetermined changes in variables, such as time of day, week, month or year (abstract, Figure 5). Consequently, Acres allows for the ability to change the sound effects and appearance of the machine in response to time (3:17-18). Applicant's admission that Acres mentions altering game appearance based on time (Instant Remarks, pg 4) and that thematic game artwork varies from machine to machine (Remarks received 9/23/02, pg 9) are each noted. Hence, all machines inherently possess thematic game artwork. Further, the claim language is interpreted as being at least background imagery of that particular machine's theme. The instant disclosure fails to provide any definition and there is no generally accepted definition within the art of record. Thus, Acres's automatic altering of background is altering thematic game artwork. The language is not so limiting as requiring change of game symbology/elements. Therefore, Applicant's claimed invention fails to preclude Acres's invention. Furthermore, based on the claim language, the Applicant is automatically

changing the ornamental design based upon time, as similarly as taught by Acres above, the ornamental design is merely used for aesthetic purposes and does not offer any distinct functional utility over the prior art, In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

*Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hirai (U.S. Patent No. 5,892,519) discloses automatically changing the thematic images based upon the time (Figures 4A-D) and was in the public's possession before Applicant's invention.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron J. Capron whose telephone number is (703) 305-3520. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

ajc  
May 1, 2003



MARK SAGER  
PRIMARY EXAMINER